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EXAMINER

KARDOS, NEIL R

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/632,392	Applicant(s) MORAES ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-268 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-268 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a **FINAL** Office Action on the merits in response to communications filed March 30, 2009. Currently, claims 1-268 are pending and have been examined.

Response to Amendment

Applicant's amendments to the claims are sufficient to overcome the claim objections set forth in the previous Office Action. Accordingly, these objections have been withdrawn.

Applicant's amendments are sufficient to overcome the § 101 rejections to independent claims 116, 173, 242, and 248 and their corresponding dependent claims. The § 101 rejections to the remainder of the claims have been maintained for reasons set forth below.

Applicant's amendments to the claims are sufficient to overcome the § 112 rejections set forth in the previous Office Action. Accordingly, these rejections have been withdrawn.

Response to Arguments

Applicant's arguments filed on March 30, 2009 have been fully considered but they are not persuasive. Applicant argues the following:

(A) All of the claims are statutory under § 101. (See Remarks, pages 23-24).

(B) Paul does not teach "providing an offer to compete to a potential competitor,"

"obtaining an acceptance to an offer to compete from a potential competitor," and

"pairing a plurality of competitors providing an indication evincing a desire to be evaluated." (See Remarks, page 28).

Applicant's arguments will now be addressed in turn.

(A) All of the claims are statutory under § 101. (See Remarks, pages 23-24).

Regarding argument (A), Examiner respectfully disagrees. The Court of Appeals for the Federal Circuit recently clarified the test for patent-eligible processes. Claims 1 and 230 are directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See in re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one. Here, process in claims 1 and 230 fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform an article to a different state. Stating that the method is "processor-implemented" in the preamble is a nominal recitation of structure that fails to make the claimed process statutory.

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Claims 58 and 236, given their broadest reasonable interpretation, are directed to software per se. These claims recite a "system" comprising "means to" perform various steps. A system is some sort of machine or apparatus. However, the claimed "means to" perform various steps could merely be software, which does not constitute a machine or apparatus. Thus, these claims are not statutory under § 101.

Claim 254 is directed to non-functional descriptive material. In other words, it is a mere collection of data "fields." Recording non-functional descriptive material on some computer-readable medium is not sufficient to make it statutory under § 101. See MPEP 2106.01.

(B) Paul does not teach "providing an offer to compete to a potential competitor," "obtaining an acceptance to an offer to compete from a potential competitor," and "pairing a plurality of competitors providing an indication evincing a desire to be evaluated." (See Remarks, page 28).

Regarding argument (B), Examiner respectfully disagrees. Paul discloses providing a web site that allows potential competitor to compete. (¶ 16). The potential competitor "selects the particular battle stage that has openings for competitors or observers." (¶ 16). By providing a web site with openings for people to compete, Paul teaches the limitation of providing an offer to compete to a potential competitor. By selecting a particular battle stage with available openings, a competitor accepts this offer to compete. Thus, Paul teaches the limitation of obtaining an acceptance to an offer to compete from a potential competitor. Once a competitor has selected a battle stage, they are paired with another competitor. (¶ 17). "Following every two contestants, those observing the rap will vote upon the preferred competitor." (¶ 17). Thus,

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Paul teaches the limitation of pairing a plurality of competitors providing an indication evincing a desire to be evaluated. Paul teaches all of the claimed limitations.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-115, 230-241, and 254-268 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 230: Claims 1 and 230 are directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See in re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

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Here, the process in claims 1 and 230 fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform an article to a different state. Stating that the method is "processor-implemented" in the preamble is a nominal recitation of structure that fails to make the claimed process statutory.

Claims 2-57: The dependent claims are rejected because they fail to add substantial limitations to remedy the deficiencies of the claims that they depend from.

Claims 231-241: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim 58: Claim 58 is rejected because it recites "means to" perform a variety of steps. These means do not necessarily constitute a physical structure (i.e. they could be software). Rather, they could simply be procedures that are followed in order to achieve a desired outcome (i.e. a collection of computer instructions). However, these procedures are not tangibly embodied on a computer-readable medium providing physical structure. The claim(s) do(es) not recite any physical structures necessary to constitute a system. Therefore, the claim(s) do(es) not fall within a statutory class of patentable subject matter.

Claims 59-115: The dependent claims are rejected because they fail to add substantial limitations to remedy the deficiencies of the claims that they depend from.

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Claim 254: Claim 254 is rejected because it is directed to non-functional descriptive material. The claimed invention is merely a collection of data ("fields"). See MPEP 2106.01.

Claims 255-268: The dependent claims are rejected because they fail to add substantial limitations to remedy the deficiencies of the claims that they depend from.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-10, 12, 14, 20, 25-26, 29-31, 35, 39, 45-47, 58-61, 63-67, 69, 71, 77, 82-83, 86-89, 93, 97, 103-105, 116-119, 121-125, 127, 129, 135, 140-141, 144-146, 150, 154, 160-162, 173-176, 178-182, 184, 186, 192, 197-198, 201-203, 207, 211, 217-219, 254-258, and 260-268 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. pre-grant publication number 2003/0171982 to Paul ("Paul").

Claim 1: Paul discloses a method of evaluating a creative work, comprising:

- providing an offer to compete to a potential competitor (see paragraph 16, disclosing a web site that offers registrants the opportunity to compete);

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- obtaining an acceptance to an offer to compete from a potential competitor (see paragraph 16, disclosing allowing registrants to choose whether or not to compete);
- pairing a plurality of competitors providing an indication evincing a desire to be evaluated (see paragraph 16, disclosing a series of one on one evaluations; paragraph 17, disclosing a tournament pairing format);
- obtaining a creative work from each paired competitor (see paragraph 17, disclosing allowing competitors to rap);
- providing the creative works from paired competitors for evaluation to an audience (see paragraph 16-17, disclosing observers);
- obtaining votes from members of the audience experiencing the creative works (see paragraph 17, disclosing voting);
- totaling votes for each creative work (see paragraph 17, disclosing counting votes with the winner advancing to compete further).

Claim 2: Paul discloses wherein the evaluation is a tournament (see paragraph 17, disclosing a tournament format).

Claim 3: Paul discloses generating an offer to compete, prior to providing the offer to compete (see paragraph 16, disclosing a web site that offers registrants the opportunity to compete).

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Claim 4: Paul discloses wherein the offer to compete is over creative works (see paragraphs 16-17, disclosing rap battles).

Claim 6: Paul discloses selecting potential competitors for evaluation, prior to providing the offer to compete (see at least paragraph 6, disclosing that potential competitors must pay a membership fee in order to receive the offer to compete).

Claim 7: Paul discloses wherein selection for an evaluation is limited by qualification (see paragraph 6, disclosing that a potential competitor must pay a membership fee to qualify).

Claim 8: Paul discloses wherein the qualifications are for potential competitors (see id.).

Claim 9: Paul discloses wherein the qualifications are for creative works (see paragraph 8, disclosing that rap submissions are limited by word length and content).

Claim 10: Paul discloses wherein qualification is based on hand-selection (see paragraph 8, disclosing humans examining verses for compliance with rules).

Claim 12: Paul discloses wherein hand-selection is made by a division (see paragraph 6, disclosing dividing competition areas into sections according to age, sex, performance style, genre, etc.).

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Claim 14: Paul discloses wherein qualifications are based on criteria stored in a database (see paragraph 7, disclosing storing registration information in a database).

Claim 20: Paul discloses wherein selected competitors are paired at random (see paragraph 17, disclosing wherein a “stage” is open until it is filled).

Claim 25: Paul discloses wherein the offer to compete is provided to a plurality of potential competitors (see at least paragraph 16, disclosing a web site that offers registrants the opportunity to compete).

Claim 26: Paul discloses wherein the indication is an acceptance to an offer to compete (see paragraph 16, disclosing allowing registrants to choose whether or not to compete).

Claim 29: Paul discloses wherein paired competitors have a limited time in which to provide creative works (see at least paragraph 17, disclosing allowing competitors 30 seconds to spit their rap).

Claim 30: Paul discloses wherein paired competitors may employ feedback from audience members to update their creative work (see paragraph 17, disclosing allowing competitors to chat with viewers).

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Claim 31: Paul discloses wherein competitors are to be paired at random (see paragraph 17, disclosing wherein a “stage” is open until it is filled).

Claim 35: Paul discloses wherein audience members are limited by qualifications (see paragraphs 6 and 15, disclosing wherein observers must register and pay a membership fee).

Claim 39: Paul discloses wherein qualifications are based on criteria stored in a database (see paragraph 7, disclosing storing registration information in a database).

Claim 45: Paul discloses wherein the audience members provide feedback to paired competitors (see paragraph 17, disclosing observers chatting with competitors and voting on competitors' works).

Claim 46: Paul discloses wherein a winner is determined for an evaluation (see paragraph 17, disclosing tournament winners).

Claim 47: Paul discloses wherein a winner is provided to an audience (see paragraph 17, disclosing selecting winners to participate in live concerts).

Claim 254: Paul discloses a medium readable by a processor, comprising execution-instruction signals in the processor readable medium, wherein the execution-instruction signals are issuable by the processor and include:

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- a competitor identifier field (see paragraphs 16-17, disclosing a field for a competitor's user name, a chat function allowing users to communicate and be identified by user name, and a voting function that allows a user to vote for a particular competitor);
- a creative work format field, wherein the format field specifies a format type for evaluation of creative works (see paragraph 17, disclosing choosing a genre; paragraphs 8 and 10, disclosing text, audio, and video formats);
- a deadline field, wherein the deadline specifies a time allotment for submission of a creative work (see paragraph 17, disclosing a timer presenting the remaining time).

Claim 255: Paul discloses wherein the competitor identifier identifies a specific competitor (see paragraphs 16-17 as discussed above).

Claim 256: Paul discloses wherein the competitor identifier identifies criteria for selecting a potential competitor (see paragraphs 16-17 as discussed above; specifically the voting function).

Claim 257: Paul discloses wherein the criteria includes criteria saved in a database (see paragraph 7).

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Claim 258: Paul discloses wherein the criteria includes divisions (see paragraphs 6 and 14, disclosing separate competition areas based on different languages, subject matter, age, sex, etc.; paragraph 18, disclosing inputting geographic information).

Claim 260: Paul discloses wherein the criteria includes divisions (see paragraphs 6, 14, and 18).

Claim 261: Paul discloses wherein the criteria includes geographic regions (see paragraphs 6, 14, and 18).

Claim 262: Paul discloses wherein the format type includes a duration for the creative work (see paragraph 17, disclosing a time).

Claim 263-267: Paul discloses wherein the format type includes multimedia, including audio, video, text, and graphics (see paragraphs 8 and 10, disclosing text, audio, and video).

Claim 268: Paul discloses wherein the format type includes a size limitation of the creative work (see paragraph 10, disclosing a size limitation).

Claims 58-60, 63-67, 69, 71, 77, 82-83, 86-89, 93, 97, 103-105, 116-119, 121-125, 127, 129, 135, 140-141, 144-146, 150, 154, 160-162, 173-176, 178-182, 184, 186, 192, 197-198, 201-203, 207, 211, and 217-219: These claims are substantially similar to the claims rejected above,

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except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 22-24, 27, 33-34, 62, 79-81, 84, 91-92, 120, 137-139, 142, 148-149, 177, 194-196, 199, and 205-206 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of U.S. pre-grant publication number 2003/0190960 to Jokipii et al (“Jokipii”).

Claim 5: Paul does not explicitly disclose wherein the offer to compete is upon request of an offering competitor.

Jokipii teaches protected and private game rooms that are only available to invited players.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the private rooms taught by Jokipii when competitors desire to compete in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. two competitors can choose to compete against one another).

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Claim 22: Paul does not explicitly disclose wherein selected competitors are paired through hand-selection.

Jokipii teaches manual pairing of competitors (see paragraph 37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the manual pairing taught by Jokipii when pairing competitors in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. manually paired competitors).

Claim 23: Paul does not explicitly disclose wherein selected competitors are paired through the issuance of an offer to compete and the acceptance of an offer to compete.

Jokipii teaches protected and private game rooms that are only available to invited players.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the private rooms taught by Jokipii when competitors desire to compete in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. two competitors can choose to compete against one another).

Claim 24: Paul discloses wherein hand-selection is made by an audience (see paragraph 17, disclosing a tournament style competition where audience members vote on who will advance and thus choose which competitors will be paired).

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Claim 27: Paul does not explicitly disclose wherein the indication is an acceptance to an offer to compete.

Jokipii teaches protected and private game rooms that are only available to invited players.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the private rooms taught by Jokipii when competitors desire to compete in the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. two competitors can choose to compete against one another).

Claim 33: Claim 33 is substantially similar to claim 22 and is rejected for similar reasons.

Claim 34: Claim 34 is substantially similar to claim 23 and is rejected for similar reasons.

Claims 62, 79-81, 84, 91-92, 120, 137-139, 142, 148-149, 177, 194-196, 199, and 205-206: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

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Claims 15-16, 19, 21, 32, 40-41, 44, 72-73, 76, 78, 90, 98-99, 102, 130-131, 134, 136, 147, 155-156, 159, 187-188, 191, 193, 204, 212-213, and 216 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul.

Claim 15: Paul discloses wherein the criteria includes membership in a division (see paragraph 14, disclosing separate competition areas based on different languages, subject matter, age, sex, etc.; paragraph 18, disclosing inputting geographic information).

Paul does not explicitly disclose wherein this criteria is stored in a database.

Examiner takes Official Notice that it was well-known in the computing arts at the time the invention was made to store information from a web site user in a database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use well-known computing techniques to store the information disclosed by Paul (e.g. language, age, sex, location). One of ordinary skill in the art would have been motivated to do so for the benefit of efficiency gained by storing information (e.g. the information is only input once rather than every time the user accesses the system).

Claim 16: Paul discloses wherein membership in a division is based on geography (see paragraphs 14 and 18, discussed above).

Claim 19: Paul discloses wherein the criteria includes demographics (see paragraphs 14 and 18, discussed above).

Paul does not explicitly disclose wherein this criteria is stored in a database. See claim 15 rejection for reasoning of why this would be obvious to one of ordinary skill in the art.

Claim 21: Paul does not explicitly disclose wherein selected competitors are paired in a round-robin manner .

However, Paul does disclose that persons may not be eliminated until they have lost two or even more one on one competitions (see paragraph 17).

Examiner takes Official Notice that it is well-known in the competitive tournament arts to have competitors compete in a round-robin manner. For example, the format of the World Cup includes round-robin tournament play.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a round-robin format in the tournament disclosed by Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the tournament arts.

Claim 32: Claim 32 is similar to claim 21 (above) and is rejected for similar reasons.

Claim 40: Claim 40 is similar to claim 15 except it relates to storing information regarding audience membership in a division rather than storing information related to competitor's membership in a division. Paragraphs 14 and 18 disclose criteria used for both participants and observers. Claim 40 is rejected for reasons similar to claim 15.

Claim 41: Claim 41 is similar to claim 16 and is rejected for similar reasons (see also claim 40 rejection, above).

Claim 44: Claim 44 is similar to claim 19 and is rejected for similar reasons (see also claim 40 rejection, above).

Claims 72-73, 76, 78, 90, 98-99, 102, 130-131, 134, 136, 147, 155-156, 159, 187-188, 191, 193, 204, 212-213, and 216: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 11, 13, 17-18, 28, 36-38, 42-43, 48-50, 54, 68, 70, 74-75, 85, 94-96, 100-101, 106-108, 112, 126, 128, 132-133, 143, 151-153, 157-158, 163-165, 169, 183, 185, 189-190, 200, 208-210, 214-215, 220-222, 226, and 259 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of U.S. patent number 7,162,433 to Foroutan (“Foroutan”).

Claim 11: Paul does not explicitly disclose wherein hand-selection is made by an audience.

Foroutan teaches using experts to review content submitted by potential contestants in order to decide which potential contestants are entered into the contest (see column 13: lines 2-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use expert reviewers as taught by Foroutan to filter potential contestants for entry into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g., a pool of entrants selected by experts).

Claim 13: Paul does not explicitly disclose wherein qualification is random.

Foroutan teaches randomly filtering contestants for entry into a creative works competition (see column 19: lines 57-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the random filtration taught by Foroutan when selecting contestants for entry into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a random pool of entrants).

Claim 17: Paul does not explicitly disclose wherein membership in a division is based on ranking.

Foroutan teaches scoring and ranking creative works and selecting the top ranked works for entry into a contest (see column 24: line 42 through column 25: line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the scoring system taught by Foroutan to filter potential contestants for entry into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a pool of entrants consisting of the top-ranked works).

Claim 18: Paul does not explicitly disclose wherein criteria includes a ranking. This claim is substantially similar to claim 17 and is rejected for similar reasons.

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Claim 28: Paul does not explicitly disclose wherein none of the paired competitors may view one another's creative works until the creative works are ready for evaluation by an audience.

Foroutan teaches limiting access to creative works entered in the contest, including not allowing artists to view one another's works (see column 25: lines 32-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to limit access to creative works in a contest as taught by Foroutan when carrying out the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. artists cannot "cheat" or be placed in an advantageous position by viewing the works of others).

Claim 36: Paul does not explicitly disclose wherein qualification of audience members is based on hand-selection.

Foroutan teaches pre-identifying, pre-registering, and pre-qualifying industry experts to review creative work submissions (see column 14: lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to hand select qualified experts as taught by Foroutan to judge the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. audience members are experts in the field and thus have specialized knowledge that can be applied when judging the competition).

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Claim 37: Paul does not explicitly disclose wherein audience member qualification is made by a division.

Foroutan teaches selecting audience members who belong to a particular demographic or company (see column 14: lines 35-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the audience selection criteria of Foroutan when selecting individuals to view and judge the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. audience members of a particular demographic may be more interested in judging a particular competition).

Claim 38: Paul does not explicitly disclose wherein audience member qualification is random.

Foroutan teaches randomly selecting an audience to review creative works (see column 21: lines 38-42; column 22: lines 18-23 and 58-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to randomly select audience members as taught by Foroutan when conducting the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a random audience for viewing and judging).

Claim 42: Paul does not explicitly disclose wherein audience membership in a division is based on a ranking.

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Foroutan teaches different ranks for reviewers that determine whether or not they can vote in certain competitions (see column 31: lines 6-14 and column 31: line 64 through column 32: line 2, disclosing “Expert Reviewers” and “Super Reviewers”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the audience ranking taught by Foroutan when selecting audience members to judge the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. the competitors can be judged by higher-ranked reviewers with more expertise).

Claim 43: Paul does not explicitly disclose wherein criteria includes a ranking. This claim is substantially similar to claim 42 and is rejected for similar reasons.

Claim 48: Paul does not explicitly disclose adjusting rankings based on voting results.

Foroutan teaches ranking contestants and their works according to votes received by audience members (see column 32: lines 15-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust scores for the competitors in the competition of Paul using the scoring methods taught by Foroutan. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. ranking competitors based on votes received in order to determine a winner).

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Claim 49: Claim 49 is substantially similar to claim 48 and is rejected for similar reasons.

Claim 50: Claim 50 is substantially similar to claim 48 and is rejected for similar reasons.

Claim 54: Paul does not explicitly disclose wherein rankings are also based on the format of the creative works.

Foroutan teaches scoring competitors (see column 32: lines 15-61) that compete in different creative works competitions (see column 11: lines 14-25; column 13: lines 60 through column 14: line 3; column 21: line 28 through column 23: line 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to score different creative works competitions separately as taught by Foroutan when carrying out the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. creative works are compared to other creative works of the same type – comparing “apples to apples”).

Claim 259: Paul does not explicitly disclose wherein the criteria includes rankings.

Foroutan teaches scoring and ranking creative works and selecting the top ranked works for entry into a contest (see column 24: line 42 through column 25: line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the scoring system taught by Foroutan to filter potential contestants for entry

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into the competition of Paul. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a pool of entrants consisting of the top-ranked works).

Claims 68, 70, 74-75, 85, 94-96, 100-101, 106-108, 112, 126, 128, 132-133, 143, 151-153, 157-158, 163-165, 169, 183, 185, 189-190, 200, 208-210, 214-215, 220-222, and 226:

These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 51-53, 109-111, 166-168, and 223-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Foroutan, and further in view of Jokipii.

Claim 51: Paul and Foroutan do not explicitly disclose wherein rankings take experience into account for a competitor.

Jokipii teaches various ranking systems, including a "ladder system" that ranks players based on their total number of wins (see paragraphs 50-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a competitor's experience as taught by Jokipii into the ranking system of Foroutan when ranking competitors in Paul's competition. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a ranking system that takes more than one round of competition into account).

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Claim 52: Paul and Foroutan do not explicitly disclose wherein rankings are also based on competitors' current rankings.

Jokipii teaches various ranking systems, including one that takes into account the current rankings of competitors when determining a new ranking (see paragraphs 50-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a competitor's current ranking as taught by Jokipii into the ranking system of Foroutan when ranking competitors in Paul's competition. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a ranking system that rewards players for beating higher ranked opponents).

Claim 53: Claim 53 is substantially similar to claim 52, and is rejected under a similar rationale. However, claim 53 bases new rankings on the current ranking of a creative work, rather than the current ranking of a competitor.

Because the combination of Foroutan and Paul teaches ranking creative works (see at least claim 50 rejection) and Jokipii teaches using current rankings to determine new rankings, claim 50 is merely a combination of known elements. In combination, these elements would perform the same function as they did separately, and one of ordinary skill would have recognized that the result of this combination is predictable.

Claims 109-111, 166-168, and 223-225: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer

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readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 55-57, 113-115, 170-172, and 227-229 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Foroutan, and further in view of U.S. patent number 5,916,024 to Von Kohorn (“Von Kohorn”).

Claims 55-57: Paul and Foroutan do not explicitly disclose the limitations of these claims.

Von Kohorn discloses wherein rankings are also based on criteria stored in a database, wherein the criteria includes membership in a division, and wherein criteria includes demographics (see column 9: lines 9-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the stored demographic and divisional data of Van Kohorn into the ranking system of Foroutan when ranking competitors in Paul’s competition. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. ranking North American competitors separately from European competitors).

Claims 113-115, 170-172, and 227-229: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

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Claims 230-233, 236-239, 242-245, and 248-251 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokipii in view of Foroutan.

Claim 230: Jokipii discloses a method of reporting evaluations, comprising:

- updating rankings for competitors (see paragraphs 50-51);
- generating lists of competitors by criteria (see figure 7); and
- listing potential competitors by criteria (see figure 7).

Jokipii does not explicitly disclose wherein the rankings are based on evaluations by audience votes for creative works.

Foroutan discloses these limitations (see at least column 32: lines 15-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Foroutan's ranking method when updating the rankings of Jokipii. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. rankings for creative works are based on their appeal to an audience).

Claim 231: Jokipii discloses wherein the criteria is saved in a database (see paragraph 29).

Claim 232: Jokipii discloses wherein the criteria includes divisions (see figure 7, disclosing different rating divisions [2100+, 1800-2099, etc.]).

Claim 233: Jokipii discloses wherein the criteria includes rankings (see figure 7).

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Claims 236-239, 242-245, and 248-251: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Claims 234-235, 240-241, 246-247, and 252-253 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokipii in view of Foroutan, and further in view of Paul.

Claims 234-235: Jokipii does not explicitly disclose wherein the criteria includes demographics or geographic regions.

Paul discloses inputting demographic and geographic information for a competitor (see paragraph 14, disclosing separate competition areas based on different languages, subject matter, age, sex, etc.; paragraph 18, disclosing inputting geographic information).

Official Notice is taken that it was well-known in the arts at the time the invention was made to use various identifying criteria to filter individuals by geographic or demographic information. For example, this is often used in the advertising industry to target a particular market segment.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the input demographic and geographic disclosed by Paul to filter the lists of competitors disclosed by Jokipii according to well-known methods. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art (e.g. a ranked list of competitors from North America or a ranked list of female competitors).

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Claims 240-241, 246-247, and 252-253: These claims are substantially similar to the claims rejected above, except that they are directed to a system, apparatus, and computer readable medium for performing the method steps rejected above. Thus, they are rejected under similar rationale.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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